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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Docket No: A7834

Lester F. LUDWIG, et al.

Appln. No.: 09/702,737

Group Art Unit: 2153

Confirmation No.: 3630

Examiner: D. Dinh

Filed: November 1, 2000

For: PARTICIPANT DISPLAY AND SELECTION IN VIDEO CONFERENCE CALLS

SUBMISSION OF APPELLANTS' REPLY BRIEF ON APPEAL

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Commissioner for Patents

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Technology Center 2100

Sir:

Submitted herewith please find an original and two copies of Appellants' Reply Brief on Appeal Under 37 C.F.R. §1.193(b). The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

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Diana Schaller



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Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellants respectfully submit this Reply Brief in response to the Examiner's Answer dated May 20, 2003.

The Examiner has maintained his rejections of claims 21-41 under 35 U.S.C. § 103(a), asserting that these claims are unpatentable over USP 5,195,086 to Baumgartner et al., in view of Marshak, "BeyondMail for Windows", and Rangan et al., "Software Architecture for Integration of Video Services in the Etherphone System". Appellants respectfully disagree.

The Examiner states that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art, citing *In re Keller*, 642 F.2D 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, Appellants have noted that there

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are exceptions to this test, as provided in MPEP § 2143.01. Accordingly, Appellants assert that the Examiner's citation of prior art and the Examiner's §103(a) rejection are inappropriate.

1. The First and Second Directory

Independent claims 21 and 30 of the present application explicitly recite a first directory and a second directory being a subset of the first directory.

The Examiner has acknowledged that Baumgartner does not disclose the recited first and second directory. The Examiner has asserted that Marshak discloses a two level directory, the public address book and the private address book, but has also acknowledged that Marshak does not disclose that the private address book is a subset of the public address book. The Examiner then asserts that it would have been obvious for one of ordinary skill in the art to provide a private address book which is a subset of the public address book. Appellants respectfully disagree.

The Federal Circuit has held that if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Appellants assert that the Examiner's modification of Marshak will render Marshak's e-mail system unsatisfactory for its intended purpose. Marshak provides an e-mail system offering traditional mail functionality (see Marshak, page 1, second paragraph). The Marshak e-mail system has a public address book maintained by an e-mail administrator, and an individual

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private address book. As Appellants have pointed out in their Appeal Brief, an e-mail system may have a public directory, which allows a user of the e-mail system to address other users of the e-mail system conveniently. However, a user of such an e-mail system wants to communicate with e-mail users outside his/her own e-mail system, or the public directory. It appears that the Examiner agrees with Appellants on this point. The Examiner states that it is well known that a user would store in the private directory addresses for quick access, including personal addresses and corporate addresses from the global directory (see the Examiner's Answer, page 7, lines 13-15).

Thus, the Examiner's proposed modified system would prevent users of the Marshak e-mail system from conveniently communicating with users outside the Marshak public address book, if Marshak's private address book were modified to be a subset of its public address book, as the Examiner has proposed. Accordingly, the Examiner's proposed modification would render the Marshak e-mail system unsatisfactory for its intended purpose.

Therefore, Appellants assert that there is no suggestion or motivation to make the modification the Examiner has proposed.

2. Video Capture Capabilities

Independent claims 21 and 30 of the present application recite a plurality of participants, each having associated video capture capabilities.

The Examiner has acknowledged that Baumgartner does not disclose usage of video capture capabilities, but has asserted that Rangan teaches a system for video/audio conferencing

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having video capture capabilities. The Examiner then asserts that it would have been obvious for one of ordinary skill in the art to have video capabilities with Baumgartner system. Appellants respectfully disagree.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Appellants cited *In re Gordon* for this proposition earlier. *See also* MPEP § 2143.01, *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

As shown in Fig. 1 of Rangan, the Rangan system has an out-of-band video architecture, employing an external video network. However, Baumgartner teaches elaborating in-band networking for a few media, including data and voice. The Rangan system and the Baumgartner system are not technically consistent in their approaches. The combination of the Rangan system and the Baumgartner system proposed by the Examiner would change the principles of the operation of these systems. Accordingly, contrary to the Examiner's assertion, Rangan and Baumgartner are not sufficient to render the present application's video enabled teleconferencing system obvious.

Therefore, Appellants assert that the Examiner's citation of Rangan and Baumgartner is improper.

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3. Definition of Subset

The Examiner has asserted that Marshak's private address book only needs one entry in common with its public address book to be a 'subset' of the public address book. Appellants respectfully disagree.

A subset is a set that is a part of a larger set (Webster's Encyclopedic Unabridged Dictionary of the English Language, 1996, Gramercy Books), or a set contained within a set (The American Heritage Dictionary of the English Language, Third Edition, 1996, Houghton Mifflin Company). Thus, each and every element of a subset must come from the larger set. One common entry is not enough to make a private address book a subset of a public address book.

In addition, for claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 34 U.S.P.Q.2d 1321 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370, 38 U.S.P.Q.2d 1461 (1996) (citing *In re Vogel*, 422 F.2d 438, 441, 164 U.S.P.Q. 619, 621 (CCPA 1970)). Claims must be read in view of the specification, of which they are a part. *Scimed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 58 U.S.P.Q.2d 1059 (Fed. Cir. 2001) (citing *Markman, supra*). The Federal Circuit has stated that the specification is "always highly relevant to the claim construction analysis" and often is "the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582, 39 U.S.P.Q.2d 1573 (Fed. Cir. 1996) (citing *Markman, supra*).

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In the present application, the second directory is addressed through the concepts of "quick dial". Entries from a larger directory are dragged into a "quick dial" directory of potential participants with whom frequent and rapid real-time communication is common (the present application, page 31, lines 6-14). The second directory is populated by entries dragged from the first directory. Thus, each and every element of the second directory is an element of the first directory.

Therefore, Appellants assert that the Examiner's definition of subset is not accurate.

Accordingly, even if a private directory contains addresses from a global directory, it is not a subset of the global directory, as long as the private directory contains addresses not from the global directory. Thus, the Examiner's argument that the private directory inherently is a subset of the global directory is incorrect.

The Examiner's other arguments on the merits appear to repeat points made in the Office Actions. Appellants believe that their Appeal Brief frames their response completely, and so no further response is required here.

Therefore, Appellants assert that independent claims 21 and 30 of the present application are patentable. Dependent claims 22-29 and 31-41 are patentable at least by virtue of their dependence on the patentable independent claims.

For all the reasons which have been discussed in detail above, claim 26 is patentable at least by virtue of its dependence from patentable independent claim 21. Furthermore, while Appellants have not argued this previously, in response to the Examiner's arguments Appellants



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note that claim 26 requires that the teleconferencing system default to a default communication type upon selection of a participant. The part of Baumgartner cited by the Examiner only teaches adding applications to a "conference room" after a call has been established. Baumgartner fails to teach the features cited in claim 26 of the present application. Accordingly, dependent claim 26 is patentable for this additional reason as well.

CONCLUSION

For the above reasons as well as the reasons set forth in Appellants' Brief on Appeal, Appellants respectfully request that the Board reverse the Examiner's rejections of all claims on Appeal, and pass the application to allowance at the earliest opportunity. The present Reply Brief is being filed in triplicate. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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